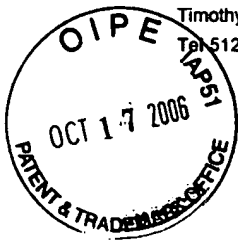


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CERTIFICATE OF EXPRESS MAILING

NUMBER: EV918016059US

DATE: October 17, 2006

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October 17, 2006

MAIL STOP APPEAL BRIEF-PATENTS

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Re: U. S. Patent Application Serial No. 09/083,422 entitled "A STORAGE SYSTEM FOR VEHICLES" by Scott Clare
(Our Ref. No.: INN643/4-013/58000)
Confirmation No. 3984

Dear Sir:

Enclosed for filing in the above-referenced patent application are the following:

1. Reply Brief in triplicate (8 pages each); and
2. Postcard.

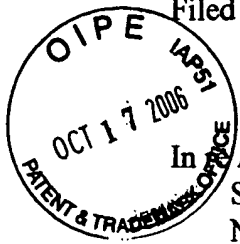
If any fees are due related to this filing, the Commissioner is authorized to appropriately deduct the requisite amount from Vinson & Elkins L.L.P. Deposit Account No. 22-0365/INN643/4-13US/58000.

Very truly yours,

Timothy S. Corder
Reg. No. 38,414

9282:3058
Enclosures

Serial No. 09/083,422
Filed 05/22/98



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Scott Clare
Neil G. Long

Serial No.: 09/083,422

Filed: May 22, 1998

For: A STORAGE SYSTEM FOR VEHICLES

Group Art Unit: 3612

Examiner: Dennis H. Pedder

Atty. Dkt. No.: INN643/4-013

Confirmation No. 3984

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MAIL STOP APPEAL BRIEF-PATENTS

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

This paper is filed in response to the Examiner's Answer to Appellants Brief on Appeal of August 17, 2006. This paper is thus believed to be timely filed. No fees are believed to be due with the filing of this Reply Brief, however, should any fees be deemed to be due for any reason, the Commissioner is authorized to charge those fees to Vinson & Elkins L.L.P. deposit account No. 22-0365/INN643/4-013/58000.

REMARKS

Appellants respectfully submit that the Brief on Appeal sets forth clear arguments that are supported by relevant case law that the Final Office Action has failed to make a *prima facie* case of obviousness against the rejected claims. The Examiner's Answer in response to that brief does not appear to even attempt to address the shortcomings of the obviousness rejections, but rather just repeats the unsupported conclusory statements that are of record in the Final Office Action.

To briefly summarize, Appellants' invention is directed to particular types of vehicles that have become quite popular over the last few decades and are exemplified by vans or mini-vans and sport utility vehicles as described and shown in Appellants' application and drawings. Appellants felt that these types of vehicles suffered from a lack of enclosed storage that was separated from and did not impinge on the seating compartment. The inventive solution was to place enclosed and lockable storage compartments along the side walls around the wheel wells thus providing these vehicles with a "trunk" without sacrificing interior space inside the vehicle. These storage compartments as described by Appellants also do not disturb the aesthetic appearance of these popular consumer vehicles, but rather blend in with the exterior conformation of the vehicle. Although not all of the advantages are listed as claim elements, these advantages are inherent in the structural limitations of the claims and represent clear differences over the state of the art at the time the invention was made.

The only rejections of record are obviousness rejections. Appellants contend that the Examiner has not made a *prima facie* case of obviousness for several reasons.

There has been no attempt to analyze the claims in light of the Graham factors. Rather than a legal analysis, the Examiner's Answer lists selected six references from the more than two hundred that have been reviewed during this prosecution and the Examiner's Answer contains only discussions of the ways the prior art references could be combined to read on the claimed invention.

Out of all these two hundred references, the Answer has failed to point to a single instance of specific information in any reference that suggests their combination. Instead the rejections are based on the Examiner's understanding of general knowledge in the art. Although Appellants understand that motivation can come from general knowledge in the art or from the nature of the problem to be solved, the Answer provides no explanation of any well-known principle or problem-solving strategy to be applied to the problem of Appellants inventions, *and does not even find the principle or problem to be solved in the references themselves*, but rather fabricates the problems whole cloth, such as "to protect passengers from tools, etc. in case of a crash or sudden movement," or "in case of rain." None of these fabricated problems to be solved appear in the cited art or in Appellants' application.

Rather than respond to Appellants' responses and requests for legal analysis of the obviousness of the claims, the Answer contains dismissive, cursory remarks.

The Answer states that the motivation to combine references is "self-evident," and that to disagree with that position is "preposterous." Rather than responding to Appellants arguments with any well-reasoned legal analysis, the Answer states that Appellants arguments are "futile," "void," and "nonsense."

Because no legal basis has been established for any rejection of the claims, Appellants respectfully request the Board to overturn all the rejections of record.

Appellants will now respond to any points raised in the Examiner's Answer. Appellants will also utilize the subparagraph lettering as it is used in the Brief on Appeal.

A) Regarding the rejection of claims 49-55, 58, 60, 98-99, 101, 106, and 108-109 under 35 U.S.C. § 103(a) over Sparling in view of Hawkins, Appellants note that the Examiner has belatedly added the Stahl reference to this rejection (See Final Office Action, section 3.) Since this is a new ground of rejection, Appellants hereby request that the appeal be maintained according to 37 C.F.R. §41.39(a)(2), and will address the new rejection, which has no more merit than the rejection over Sparling in view of Hawkins.

The first part of the Examiner's stated position is that in the Sparling vehicle, the need for the storage of tools, spare parts, etc. away from the passengers in order to prevent injury upon crash or sudden movement is so obvious that any vehicle designer/engineer would be motivated to address this problem by adding the storage system described in the rejected claims. The Examiner asserts that the motivation to combine these references is self evident and that to dispute the Examiner's position is "preposterous." No further support for the rejection is provided.

Appellants acknowledge that safety is certainly a concern in vehicle design, but find no mention in Sparling of either a need for storage of tools, spare parts, etc. or of the need for protection from such objects in case of a crash or sudden movement. In fact, this is not presented as a problem to be solved in any of the cited art references or in Appellants application. But it is the Examiner's position that one of skill in the art, a vehicle designer for example, would look at the Sparling, Hawkins and Stahl references, and would arrive at the present claimed invention without the advantage of having seen Appellants' application. Because no other inventors developed the claimed invention

during the fourteen years after 1982 (the issue date of Sparling) in spite of the popularity of the claimed vehicle types, this assertion is suspect. And yet, the Answer offers no explanation of how the prior art would even suggest the problem to one of skill in the art.

The Answer also regards Appellants' statements that their own motivation to "utilize space that is typically inaccessible or poorly accessible" as "futile" because those terms don't appear in a claim. The statements referred to by the Answer are discussions of certain advantages of the claimed inventions that are inherent in the claimed structures and are indices of non-obviousness. Appellants are aware of no legal requirement to state advantages of a structural invention in the claims. Rather than address this issue, however, the Examiner's Answer merely dismisses an argument that he cannot overcome with a cursory statement that has no basis in patent law or practice.

In the final statement of section (A) in the Examiner's Answer, there is another "off the cuff" cursory remark that refuses to address the issues of the current appeal. Appellants' statements regarding how one would modify the prior art disclosures assumed that the Examiner would understand that Appellants were questioning how the Examiner proposed that the prior art disclosures could be modified to be combined in such a way that the modified vehicles would still be suitable for their own intended purposes. The vehicles of Hawkins and Stahl are so different from the vehicle in Sparling that Appellants wanted clarification of how the prior art suggested to the Examiner that any such modification could be accomplished, not of how one would open a door into a storage compartment. Again the Examiner is unable to provide any evidence or legal analysis to support a finding of obviousness.

Because the Examiner has not made a *prima facie* case of obviousness, Appellants again request the Board to overturn the rejections of claims 49-55, 58, 60, 98-99, 101, 106, and 108-109 under 35 U.S.C. § 103(a) over Sparling in view of Hawkins, and now further in view of Stahl.

B) This section addresses the rejection of claims 61-62, 64-68, 70-72, 111 and 113 over Stahl in view of Hawkins.

The Answer regards the relevant arguments in the Brief as "unintelligible" and "non-sense." It is clear, however, that neither vehicle described by Stahl or Hawkins meets the limitations of the rejected claims. Specifically, regarding the partition 8 of

Stahl, this partition distinguishes the reference from independent claim 61, which includes the following elements:

a rear compartment for passengers, merchandise or equipment wherein the rear compartment is disposed to the rear of the driver compartment, wherein the forward and rear compartments are contained in a single enclosure, and further wherein the rear compartment is bounded by exterior, contoured side panels and a rear, including at least one rear door, and optionally at least one rear side door, and wherein each side panel has a lower perimeter that includes a curve to accommodate a rear wheel well adjacent each side panel.

Appellants pointed to the partition, labeled 8 in the Stahl reference, as evidence that the rear or storage compartment of Stahl is not contained within a single enclosure with the driver's compartment as required by claim 61, but is a separate compartment. Stahl is therefore completely missing at least one element of the rejected claims. The Examiner's construction of this claim completely removes this limitation, which does not appear in Stahl or Hawkins. Appellants therefore continue to traverse this rejection since at least one claim element is completely missing from the cited art. This combination of references cannot, therefore, render the claims obvious.

Appellants respectfully request the Board to overturn the rejections over Stahl in view of Hawkins.

C), D), F) The rejections discussed in these three sections are dependent claims for which the Hamel reference has been added to obviousness rejections of the broader claims based on art that has been discussed above. Appellant has nothing further to add to the previous discussion and will let the Board decide whether the existence of rain is sufficient motivation to combine Hamel with any and all references that describe a vehicle in order to reconstruct a claimed invention.

E) Appellants are not certain of the meaning of the statement in the Examiner's Answer that Appellants' comments regarding Gallagher et al. are "void." Appellants stand by their assertion that the Gallagher reference does not cure the deficiencies in the obviousness rejections over Sparling or Stahl in view of Hawkins or in view of Hamel, and that the Examiner has failed to make a *prima facie* case of obviousness.

Appellants again respectfully request that the Board overturn the rejections of claims 59 and 88.

G) Regarding the rejection of claim 105, Appellants continue to assert that the width of the wheel wells is determined by the size of the wheels and it would be difficult to find any suggestion in the art that the wheel wells should be made larger to extend further into a passenger compartment for any reason other than to accommodate the wheels of the vehicle. In claim 105, the width of the wheel well, which is determined by the size of the wheels is the limiting factor for the size of the storage area. Thus the claimed invention again provides a storage area in a previously inaccessible or poorly accessible part of a vehicle of a certain type as described in the claims. Appellants again assert that such advantages of a structural invention are not required to appear in the claims.

Appellants respectfully maintain their request to the Board to overturn the rejection of claim 105.

H) Appellants maintain the assertion that the references of Sparling and Hawkins are not combinable since there is not motivation to combine the references and that if such a combination were used in an attempt to reconstruct the claimed inventions, then one of skill in the art would recognize that combining the teachings of the references would result in the vehicles described in Sparling and Hawkins no longer being able to function for their intended purposes. Therefore, a person of skill in the art would not be motivated to make such a combination.

Appellants maintain their previous comments in this regard and add further that the addition of utility truck side boxes as described in Hawkins would destroy the intent of the Sparling disclosure. Sparling states in column 3, line 40 that when the base mounting member 30 is appropriately mounted on the vertical sides 16 and 18 of the rear truck bed 6, the respective side members 36 and 38 extend over and cover the upper exterior portion of the truck vertical sides to provide a highly pleasing and asthetic exterior appearance. Again in column 4, line 23, Sparling states that the purpose of the tailgate apron 78 is two fold, including the improvement of the vehicle appearance for esthetic purposes. Sparling again states his object of maintaining an esthetic appearance in column 6, line 19. "This configuration provides not only a highly esthetic appearance but also a practical function of locking the lower tailgate 20 ..." This object is also evident from the drawings of Sparling, in which the overall appearance of a light duty truck is maintained after the addition of an enclosed rear seating compartment.

It is Appellants' position that modifying the Sparling vehicle to contain the utility tool boxes of Hawkins would render the Sparling vehicle unsuitable for at least one object of his invention, that of maintaining the "highly esthetic" appearance of his truck. Even though the esthetic appearance is not an element of the rejected claims, it is an object of the Sparling invention and the combination with Hawkins utility boxes as proposed by the Examiner would render the Sparling truck non-functional for at least one of its intended purposes, to modify the seating while maintaining the highly esthetic appearance of the light duty truck.

This argument is not intended to replace the previous discussions of this combination of references, but to supplement Appellants' position that the references in no way teach or suggest the claimed inventions. Appellants respectfully request the Board to overturn all rejections over the combination of Sparling with Hawkins.

I.) This section is again a general discussion of the inappropriateness of the Examiner's attempt to combine references with no legal basis to do so and his failure to make a *prima facie* case of obviousness. Appellants assert that the Examiner has not met his burden to produce any evidence of obviousness and respectfully request the Board to overturn all rejections over Stahl in view of Hawkins and/or Hamel.

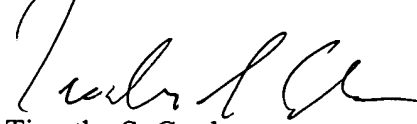
J.) Appellants assert the comments in the Examiner's Answer with respect to a reasonable expectation of success are misplaced. The question is not whether one of skill could successfully add a door and storage compartment to a vehicle if that person were given the blueprint for adding that storage as described in Appellants' application, but rather, would one of skill at a time when the invention was made, have solved the problem of adding an outside storage system like a trunk to a van or sport utility vehicle without compromising the space in the seating compartment. That is what Appellant means by considering the invention as a whole. The Examiner has ignored that aspect of the process and has persisted in trying to fit some prior art storage compartment into any kind of vehicle that didn't previously have storage using Appellants' disclosure as a blueprint.

The rejections of all claims are therefore improper and Appellants respectfully request the Board to overturn the rejections of all the pending claims.

CONCLUSION

Claims 49-56, 58-62, 64-73, 85-86, 88-89, 91, 92, 98, 99, 101, 105, 106, 108, 109, 111, and 113 are patentable over the cited prior art, and Appellants respectfully request that all rejections be overturned.

Respectfully submitted,



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Date: October 17, 2006